

Application No.: 09/870,672
Attorney's Docket No.: MA3005-0031

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the above amendments to the claims and following remarks.

Personal Interview

Applicant and the undersigned wish to thank Examiner Mathew for the courteous and productive interview conducted on June 9, 2005. In accordance with Applicant's duty under 37 C.F.R. § 1.33(b), the summary of the arguments presented during the above-referenced interview are incorporated into the following comments.

Summary of Office Action

In the January 25, 2005 Office Action, claims 1, 4, 5, 9-13, 20, 22, 23, and 32-37 were rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,293,967 to Shanley (Shanley'967) in view of Palmaz et al. WO 99/23977 (Palmaz'977). Claims 14-19 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 and further in view of U.S. Patent No. 5,788,979 to Alt et al. (Alt'979).

Summary of Response to Office Action

By this Amendment, Claim 32 has been amended and new claims 38-45 have been added. The claims currently pending in this application are claims 1, 4, 5 and 9-20, 22, 23, and 32-45. Claims 1, 32, and 33 are the only independent claims.

Pending Claims Define Allowable Subject Matter

In the January 25, 2005 Office Action, claims 1, 4, 5, 9-13, 20, 22, 23, and 32-37 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977. This rejection is respectfully traversed for the following reasons.

It is respectfully submitted that the above-referenced rejection fails to meet the prime-facie requirements for obviousness-type rejections under 35 U.S.C. §103(a). Namely, at least

one of the features recited in Applicant's claims is completely absent from the disclosure/teaching of Shanley '967 and/or Palmaz'977.

With regard to independent claims 1 and 33, there is no disclosure or teaching of at least the feature of deformable portions being formed as grooves and when the deformable portion is prolonged it forms an endless annular configuration. During the personal interview, Examiner Mathew contended that it would have been obvious to have extended the groove 400''' shown in Fig. 8 of Palmaz'977 to allegedly arrive at Applicant's inventive feature. However, no reference has been supplied that discloses or teaches a groove that, when prolonged, forms an endless annular configuration. Thus, because at least this feature is completely absent from the references that are currently relied upon in the outstanding rejection, it is respectfully submitted that the rejection fails to meet the prime-facie requirements for obviousness-type rejections, and cannot stand.

In order to establish a *prima facie* case of obviousness, the Office must satisfy three requirements. M.P.E.P. § 2142. First, "the prior art reference, or references when combined, must teach or suggest *all* the claim limitations." *Id.* (emphasis added). Second, the Office must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." *Id.* Finally, "there must be a reasonable expectation of success." *Id.*

In this case, the outstanding rejection fails to meet the first prong of the prime facie requirements for obviousness type rejections.

Although there was some discussion regarding "hindsight" during the personal interview, it is respectfully submitted that arguments concerning "hindsight" would only be relevant if the applied references included all the claimed features. In this case, even if the

references were to be combined (which Applicant does not believe is appropriate), the resulting device still would not include all the features of Applicant's claims.

With regard to claim 32, it is respectfully submitted that neither Shanley '967 nor Palmaz'977, either alone or in combination, disclose or teach at least the feature of a plurality of deformable portions located on each of the plurality of bent portions. Again, the prime facie requirements for an obviousness-type rejection are not met by the outstanding rejection of claim 32. In particular, the Examiner relies on Shanley'967 to allegedly teach the use of "wavy annular members...with bent portions (118, 122)", as stated in the 3rd paragraph on page 2 of the January 25, 2005 Office Action. The Examiner then relies on Palmaz'977 for a teaching of "grooves." However, neither reference contemplates using a plurality of deformable portions located on each of the plurality of bent portions. Moreover, the grooves 400 of Palmaz'977 are used "to increase the rate of migration of endothelial cells on and over, the inner surface of the intravascular stent." (See lines 15-20 of page 8 of Palmaz'977). By contrast, Applicant's grooves are utilized for different purposes. There is simply no teaching in either of the applied references (alone or in combination) of a plurality of deformable portions located on each of the plurality of bent portions. Thus, there is no prime facie case of obviousness.

Claims 4, 5, 9-13, 20, 22, 23 and 35 are dependent from claim 1 and include all the features of claim 1, claim 36 is dependent from claim 32 and includes all the features of claim 32 therein, and claims 34 and 37 are dependent from claim 33 and includes all the features of claim 33 therein. Accordingly, Shanley'967 and Palmaz'977, either alone or in combination, also fail to obviate the invention of claims 4, 5, 9-13, 20, 22, 23 and 34-37 for at least the reasons set forth above with respect to their respective parent claims 1, 32 and 33, and because of the separate and distinct features that these dependent claims recite.

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Shanley'967 and Palmaz'977 fail to disclose or teach, either alone or in combination, each and every element as set forth in claims 1, 4, 5, 9-13, 20, 22-23 and 32-37. Nor would it have been obvious to have combined the references as suggest by the Examiner. Accordingly, it is respectfully submitted that these claims are allowable, and that the rejection cannot be maintained. Withdrawal of the rejection under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 is respectfully requested.

Claims 14-19 were rejected under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 and further in view of Alt'449. This rejection is respectfully traversed for the following reasons.

Alt'449 fails to make up for the above-noted deficiencies of both Shanley'967 and Palmaz'977. In particular, Alt'449 fails to disclose or teach at least the feature of deformable portions being formed as grooves and when the deformable portion is prolonged it forms an endless annular configuration, as recited in independent claim 1. Claims 14-19 depend from claim 1 and include all the features of claim 1. Accordingly, claims 14-19 are allowable because of the above-noted features that are neither taught nor disclosed in Shanley'967, Palmaz'977 or Alt'449 (either alone or in combination), and for the additional features that claims 14-19 recite. Accordingly, withdrawal of the rejection under 35 U.S.C. §103(a) over Shanley'967 in view of Palmaz'977 and Alt'449 is respectfully requested.

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Conclusion

It is respectfully submitted that the amendments to the claims places this case in immediate and clear form for allowance. Accordingly, an early indication via a Notice of Allowability that all claims are allowable is respectfully requested. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-2821. If a fee is required for an extension of time under 37 C.F.R. § 1.136 is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 50-2821.

Respectfully submitted,

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